

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John Hevesi

Application No.: 10/822,159

Confirmation No.: 2644

Filed: April 12, 2004

Art Unit: 3617

For: PADDLE BLADE, SHAFT AND GRIP

Examiner: Ed Swinehart

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre Appeal Brief Request for Review

Dear Examiner:

This Request is being filed in connection with a Notice of Appeal.

Status

Claims 1, 3, and 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bier (U.S. Pat. No. 6,455,162) ("Bier") in view of Yoshida et al. (U.S. Pat. No. 4,098,840) ("Yoshida et al."). Claims 1 – 32 are pending. Claims 2 and 5 – 32 are withdrawn. Claims 1, 3, and 4 are examined on the merits.

I. Claims 1, 3, and 4 are NOT unpatentable over the combination of Bier in view of Yoshida et al.

In the Office Action dated November 26, 2008, claims 1, 3, and 4 stand rejected under 35 U.S.C. §103(a) as discussed above. For a *prima facie* case of obviousness to be established, the following factual inquiries as enunciated in *Graham* must be determined: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims at issue; (C) determining the level of skill in the pertinent art; and (D) evaluating any evidence of secondary considerations. Further, in *KSR*, a number of rationales for supporting a conclusion of obviousness consistent with the "functional approach" in *Graham* were laid out. Additionally, it is key that the Examiners articulate their reasons why the claimed invention would have been obvious. (MPEP 2143)

A. Independent Claim 1

Respectfully, the Applicant disagrees with the Examiner's rejection. The cited references do not teach or suggest all of the claim limitations found in independent claim 1.

Regarding claim 1, Bier teaches transparent water-spreading coatings that can be prepared on mouldings. (col. 3, lns. 32-33) Bier further teaches that the mouldings may be thermoplastic mouldings, such as polymethyl methacrylate, polystyrene, polyvinyl chloride, polyester, or polycarbonate. (col. 6, lns. 1-5) It further teaches that the coating is applied to the mouldings as a liquid coating and then dried. (col. 5, lns. 42-59)

Bier does not teach a gauge lens having a *single-layer film* applied to its surface that isn't a coating. Claim 1 was amended in a previous response to specifically include this negative limitation, thus Bier does not teach all the elements of claim 1 of the present application. The coating taught by Bier is a deposition coating and not a single-layer film as disclosed and claimed through the negative limitation. Thus this element is not taught by Bier.

Further, Bier does not teach the inner surface of a single-layer film being adjacent to the interior of a gauge housing. With respect to the Examiner's conclusion that the gauge housing is a recitation of the intended use of the anti-fog gauge lens, respectfully, the recitation is believed proper as it provides a limitation and point of reference for the orientation of the elements of the present anti-fog gauge lens. The structural difference remains the "...single-layer film having a first surface and a second surface, said first surface of said film is adjacent and substantially embedded and covering said inner surface of said lens, and said second surface having hydrophilic properties for preventing moisture condensation from forming on said second surface of said film, ..., wherein said single-layer film is not a deposited coating." (Claim 1)

This negative limitation, *wherein said single-layer film is not a deposited coating*, provides unambiguous boundaries for the patent protection sought in claims 1, 3, and 4. As discussed above, the present application includes a single-layer thin film and not a deposition coating, thus clearly defining what the invention is by excluding those elements and limitations that currently exist in the prior art. Some of the non-elected claims are directed to an injection molding process that incorporates the single-layer film into the substrate during an injection molding process, which is made more efficient with the single-layer film than with coatings and their time intensive deposition and drying steps.

Yoshida et al. teaches a two component coating, one component provides abrasion resistance and the other component provides anti-fogging characteristics that is cured and bonded to a substrate,

such as metal, inorganic glass, or transparent plastic. (col. 4, lns. 6-20) Like Bier, Yoshida et al. teaches coating a surface of a substrate with the two component composition prior to curing and/or drying both components. Yoshida et al. does teach using anti-fog coatings with certain substrates, such as lens and gauges; however, it does not teach a single-layer film that is located adjacent and substantially embedded and covering an inner surface of a lens. It is not clear whether the coating taught in Yoshida et al. is for use on the outer surface or inner surface of these lenses and gauges. Additionally, the Examiner states that, "...it would have been obvious to a person of ordinary skill in the art to combine the coating of Bier with a conventional gauge lens to achieve the claimed invention...." Combining these two references by one skilled in the art does not account for the differences between the prior art, specifically the differences between coatings as taught by Bier and Yoshida et al. and a single-layer film as disclosed and claimed in the present application.

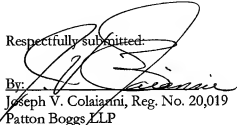
Moreover, the coatings taught by Bier and Yoshida et al. are applied to a substrate via some type of deposition process as commonly known in the art, such as spraying or dipping. As disclosed in the present application and found in the non-elected claims, the present application is directed to an injection molding process that incorporates the single-layer film into the substrate during the injection molding process for efficient manufacturing. Claim 1 has been previously amended to clarify this distinction. Further, claim 1 has been previously amended to clarify that the inner surface of the substantially planar transparent lens substrate is adjacent to the interior of a gauge housing. It is not implicit in either Bier or Yoshida et al. that an anti-fog gauge lens is used inside a gauge housing as disclosed and claimed in the present application.

Finally, these references combined do not teach all the elements of claim 1 of the present application as previously amended. Thus, each and every element as set forth in claim 1 is not found in Bier in view of Yoshida et al. For the reasons stated above with respect to both Bier and Yoshida et al., Applicant respectfully submits that it does not form the basis of a *prima facie* case of obviousness of previously amended independent claim 1. Therefore, it is believed that claim 1 is allowable under 35 U.S.C. §103(a). Claims 3 and 4 depend from previously amended claim 1 and include all its limitations, therefore they are also believed to be allowable because they are dependent upon previously amended claim 1.

Conclusion

In view of the forgoing, the Panel is respectfully requested to allow claims 1, 3, and 4. This Brief is being filed in conjunction with a Petition for a Three-Month Extension of Time. The Extension fee of \$555.00 and the Notice of Appeal fee of \$270.00 for total fees of \$825.00 are paid with this filing. Applicant believes no additional fees are due for this filing. If any additional fees are due or any overpayments have been made; however, please charge or credit Deposit Account No. 50-0709 of Patton Boggs LLP, under Order No. 022306.0101PTUS from which the undersigned is authorized to draw.

Respectfully submitted:


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